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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,559	02/06/2004	Hiromichi Kobayashi	1217-040223	3556
28289 7590 01/29/2007 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			EXAMINER LE, HOA VAN	
			ART UNIT 1752	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/29/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/773,559

Applicant(s)

KOBAYASHI ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 1-15,32-38 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-31 and 39-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15,32-38 and 51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ==:
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

This is in response to Paper filed on 18 December 2006.

I. Applicants' elect the invention of Group III, claims 16-31 and 39-50 without traverse on 18 December 2006 being acknowledged. There are two groups of claims (16 and 20-31) and (17-19 and 39-50). The record shows that they are not considered to be patentably distinct. Therefore, no restriction in between them is made. Accordingly, no separate consideration or search will be made. However, applicants should disagree, urge, show provide an evidence to the contrary for the record in the next response to this Office action in order for it to be considered timely. The evidence as urged and/or admission as stated on or for the record will be used to made a restriction in between two group of the claims in the next Office action.

II. Applicants' prior art submissions filed on 25 August 2004, 20 December 2005 and 14 September 2006 have been considered to the extent of the English language as provided.

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III. “Φm” in the elected claims 26 and 45 is an improper indication for micron.

A proper correction is requested and required before an allowance is indicated.

IV. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

A. Claims 16-31 and 39-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-6, 8, 10 and (page 2, lines 1-12, Examples and Comparative Examples and Table 1. Applicants, Powdertech Co., Ltd., and/or their counsel may state on and/or for the record that the claims are self sufficient. There has not been and will not be relied on any embodiments in the main body of a disclosure for any purpose) of copending Application No. 10/774,045. The language “melting point of not higher

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than 1000°C” “melting point of not lower than 1800°C” or “electrical resistivity...” or the like is a property or a measurement of a property of a material and considered inherent or obviously about inherent. For a patentability of a property or a measurements of a proper of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same or obviously about claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they have about the same or obviously about the same embodiments and property.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

B. Claims 16-31 and 39-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims

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6 and (col.2:25-26 and 44-48, 6:1-51, Examples 2-4 and Comparative Examples 1-4. Applicants, Powdertech Co., Ltd., and/or their counsel may state on and/or for the record that the claims are self sufficient. There has not been and will not be relied on any embodiments in the main body of a disclosure for any purpose) of copending Application No. 10/774,045. The language “melting point of not higher than 1000°C” “melting point of not lower than 1800°C” or “electrical resistivity...” or the like is a property or a measurement of a property of a material and considered inherent or obviously about inherent. For a patentability of a property or a measurements of a proper of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same or obviously about claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they have about the same or obviously about the same embodiments and property.

C. Claims 16-31 and 39-50 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8 and (col.4:40to 5:34 and 54 to 6:7, Examples 1-2 and Comparative Example 3 and Table 1. Applicants, Powdertech Co., Ltd., and/or their counsel may state on and/or for the record that the claims are self sufficient. There has not been and will not be relied on any embodiments in the main body of a disclosure for any purpose) of copending Application No. 10/774,045. The language “melting point of not higher than 1000°C” “melting point of not lower than 1800°C” or “electrical resistivity...” or the like is a property or a measurement of a property of a material and considered inherent or obviously about inherent. For a patentability of a property or a measurements of a proper of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same or obviously about claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. A showing

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should be submitted in the next response to this Office action in order for it to be considered timely.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they have about the same or obviously about the same embodiments and property.

V. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-31 and 39-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sato et al (5,976,747).

Sato et al disclose and teach a resin coated carrier core. The core comprises more than two groups of metal oxides. Please see the whole disclosure of the applied reference, especially at least col.3:6-48, 4:11 to 5:4, Examples 1-7

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and Comparative Examples 1-10. The language “melting point of not higher than 1000°C” “melting point of not lower than 1800°C” or “electrical resistivity...” or the like is a property or a measurement of a property of a material and considered inherent. For a patentability of a property or a measurements of a proper of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. In the absence of a showing of a convincing evidence to the contrary as clearly pointed out and set forth on the record, the above claims are reasonably found to be anticipated by Sato et al.

In an alternative, the remote teachings and suggestion and an obviously about inherent property or its measurement are reasonably found to be rendered *prima facie* obvious by Sato et al. An allowed claim or patent would have no value when someone shows to an obviously about the same claimed functional property as set forth on the record using all possible combinations of the teachings and

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suggestions in the applied reference. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

VI. Claims 16-31 and 39-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshizaki et al (6,372,400).

Yoshizaki et al disclose and teach a resin coated carrier core. The core comprises more than two groups of metal oxides. Please see the whole disclosure of the applied reference, especially at least col.8:48-49, 9:1-3 and 66, 10:1-32, 11:66 to 12:6 and 52 to 15:27. The language “melting point of not higher than 1000°C” “melting point of not lower than 1800°C” or “electrical resistivity...” or the like is a property or a measurement of a property of a material and considered inherent. For a patentability of a property or a measurements of a proper of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. In

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the absence of a showing of a convincing evidence to the contrary as clearly pointed out and set forth on the record, the above claims are reasonably found to be anticipated by Yoshizaki et al.

In an alternative, the remote teachings and suggestion and an obviously about inherent property or its measurement are reasonably found to be rendered prima facie obvious by Yoshizaki et al. An allowed claim or patent would have no value when someone shows to an obviously about the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

VII. Claims 16-31 and 39-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saha et al (5,2,68,249 being equivalent to JP 8022150 as cited by applicants)

Saha et al disclose and teach a resin coated carrier core. The core comprises more than two groups of metal oxides. Please see the whole disclosure of the applied reference, especially at least col.3:19-29, 3:9:12-34, Examples 1-3. The language “melting point of not higher than 1000°C” “melting point of not lower than 1800°C” or “electrical resistivity...” or the like is a property or a measurement

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of a property of a material and considered inherent. For a patentability of a property or a measurements of a proper of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. In the absence of a showing of a convincing evidence to the contrary as clearly pointed out and set forth on the record, the above claims are reasonably found to be anticipated by Saha et al.

In an alternative, the remote teachings and suggestion and an obviously about inherent property or its measurement are reasonably found to be rendered *prima facie* obvious by Saha et al. An allowed claim or patent would have no value when someone shows to an obviously about the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

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VIII. Claims 16-31 and 39-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kenji et al (JP3168377 as cited by applicants. An English language translation or equivalent is requested and required to be submitted at the same time or before an appeal brief is filed. Otherwise, the appeal brief is not considered and dismissed).

Kenji et al disclose and teach a resin coated carrier core. The core comprises more than two groups of metal oxides. Please see the abstract as provided by applicants. The language "melting point of not higher than 1000°C" "melting point of not lower than 1800°C" or "electrical resistivity..." or the like is a property or a measurement of a property of a material and considered inherent. For a patentability of a property or a measurement of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. In the absence of a showing of a convincing evidence to the contrary as clearly pointed

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out and set forth on the record, the above claims are reasonably found to be anticipated by Kenji et al.

In an alternative, the remote teachings and suggestion and an obviously about inherent property or its measurement are reasonably found to be rendered prima facie obvious by Kenji et al. An allowed claim or patent would have no value when someone shows to an obviously about the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

IX. Claims 16-31 and 39-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Masahisa et al (JP09-236947 as cited by applicants. An English language translation or equivalent is requested and required to submitted as the same time or before an appeal brief is filed. Otherwise, the appeal brief is not considered and dismissed).

Masahisa et al disclose and teach a resin coated carrier core. The core comprises more than two groups of metal oxides. Please see the abstract as provided by applicants. The language “melting point of not higher than 1000°C” “melting point of not lower than 1800°C” or “electrical resistivity...” or the like is

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a property or a measurement of a property of a material and considered inherent. For a patentability of a property or a measurements of a proper of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. In the absence of a showing of a convincing evidence to the contrary as clearly pointed out and set forth on the record, the above claims are reasonably found to be anticipated by Masahisa et al.

In an alternative, the remote teachings and suggestion and an obviously about inherent property or its measurement are reasonably found to be rendered prima facie obvious by Masahisa et al. An allowed claim or patent would have no value when someone shows to an obviously about the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

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X. Claims 16-31 and 39-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kenji et al (JP8069131 as cited by applicants. An English language translation or equivalent is requested and required to be submitted at the same time or before an appeal brief is filed. Otherwise, the appeal brief is not considered and dismissed).

Kenji et al disclose and teach a resin coated carrier core. The core comprises more than two groups of metal oxides. Please see the abstract as provided by applicants. The language "melting point of not higher than 1000°C" "melting point of not lower than 1800°C" or "electrical resistivity..." or the like is a property or a measurement of a property of a material and considered inherent. For a patentability of a property or a measurement of a property of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. In the absence of a showing of a convincing evidence to the contrary as clearly pointed

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out and set forth on the record, the above claims are reasonably found to be anticipated by Kenji et al.

In an alternative, the remote teachings and suggestion and an obviously about inherent property or its measurement are reasonably found to be rendered prima facie obvious by Kenji et al. An allowed claim or patent would have no value when someone shows to an obviously about the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

XI. Claims 16-31 and 39-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Masahiro et al (JP8194338 as cited by applicants. An English language translation or equivalent is requested and required to submitted as the same time or before an appeal brief is filed. Otherwise, the appeal brief is not considered and dismissed).

Masahiro et al disclose and teach a resin coated carrier core. The core comprises more than two groups of metal oxides. Please see the abstract as provide by applicants. The language “melting point of not higher than 1000°C” “melting point of not lower than 1800°C” or “electrical resistivity...” or the like is a

property or a measurement of a property of a material and considered inherent. For a patentability of a property or a measurements of a proper of a material embodiment, it is allowed by law to request and require applicants to convincingly show or provide an evidence to the contrary since arguments alone are not a factual evidence in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An allowed claim or patent would have no value when someone shows to the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. In the absence of a showing of a convincing evidence to the contrary as clearly pointed out and set forth on the record, the above claims are reasonably found to be anticipated by Masahiro et al.

In an alternative, the remote teachings and suggestion and an obviously about inherent property or its measurement are reasonably found to be rendered prima facie obvious by Masahiro et al. An allowed claim or patent would have no value when someone shows to an obviously about the same claimed functional property as set forth on the record using all possible combinations of the teachings and suggestions in the applied reference. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

XII. At least the following references have the same or about the same teachings and suggestions as that of each of those applied above and are cumulative but may belater applied. They are Baba (5439771 5576133), Hayashi et al (5686012), Masawa et al (5688852), Okado et al (5795693), Uchida et al (5843610), Ochiai et al (5876893 5900343), Mahabadi et al (5998076), Aita et al (6157801, Kobayashi et al (6627369) and Takiguchi et al (2002/0037470).

XIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status

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information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
15 January 2007

HOA VAN LE
PRIMARY EXAMINER
